

Application No.: 10/822,428  
Amendment dated: December 26, 2006  
Reply to Office Action of September 26, 2006  
Attorney Docket No.: 21295.79 (H5786US)

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**c.) Remarks**

Claims 1-16 are pending in this application. Claims 1, 2, 5, 9, 11-14 and 16 have been amended in various particulars as indicated hereinabove. Claims 3 and 4 have been cancelled and all elements of these claims were incorporated into amended Claim 1. Claim 17 is new. Referenced Claims have also been amended to make their language conform to the US patent practice, and eliminate some language inconsistencies present due to the German-English translation.

Turning first to the Office Action Summary Sheet, Claims 1-16 are pending in this application. Claims 1-16 are rejected.

Turning now to the merits, Claims 1-16 were rejected under, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants believe that the present amendments address this rejection and make the Claims compliant with the requirements of 35 U.S.C. 112. Withdrawal of the rejection of Claims 1-16 is respectfully requested.

Claims 1-3, 5, 6, 8, 9 and 11-15 were rejected under 35 U.S.C. 102(b) over Lybarger et al. (Cytometry (1998) Volume 31, pages 147-152). This rejection is respectfully traversed for the following reasons.

It is well established that a claim is anticipated under 35 U.S.C. §102, only if each and every element of the claim is found in a single prior art reference.<sup>1</sup> Moreover, to anticipate a claim under 35 U.S.C. §102, a single source must contain each and every element of the claim "arranged as in the claim."<sup>2,3</sup> Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference.<sup>4</sup>

<sup>1</sup> *Veregal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2USPQ2d 1051, 1053 (Fed. Cir. 1987).

<sup>2</sup> *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

<sup>3</sup> *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q. 2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988).

<sup>4</sup> *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

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If each and every element of a claim is not found in a single reference, there can be no anticipation.

Applicants respectfully assert that Lybarger et al. does not disclose, teach or suggest a method for separating detection channels, wherein the separation points between the portions of the emission spectrum are determined by minimizing an integral of a square of a difference between an emission spectrum of one fluorescent dye present in the sample and measured emission spectra of at least two dyes present in the sample, as claimed now in amended independent Claim 1. Nowhere in Lybarger et al. could such elements be found. Therefore, Lybarger et al. does not disclose each and every element of the invention as claimed in amended independent Claim 1. Therefore, Claim 1 is patentable over Lybarger et al. under 35 U.S.C. 102(b).

Moreover, Claim 4 as originally presented has not been rejected by the Patent Office under 35 U.S.C. 102(b), but only under 35 U.S.C. 112 as dependent on the rejected base Claim 1. Since amended Claim 1 now complies with 35 U.S.C. 112, and since amended Claim 1 now incorporates the limitations of Claim 4 and the intervening Claim 3, Applicants assert that amended Claim 1 is now allowable.

Claims 2, 5-16 are directly or indirectly dependent on amended Claim 1 and are, therefore, patentable over the Lybarger et al.

Applicants also respectfully note that Claims 7 and 10 as originally filed have only been rejected under 35 U.S.C. 112, which rejection has now been overcome by the present amendments to the Claims. Additionally, Applicant introduced new Claim 17, which is Claim 10 rewritten in the independent format and incorporating the elements of intervening Claim 9.

Claim 16 was rejected under 35 U.S.C. 103(a) over Lybarger et al. (Cytometry (1998) Volume 31, pages 147-152). This rejection is respectfully traversed for the same reasons as resented above.

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For an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case of obviousness. The Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the cited publications, which must have a suggestion, teaching or motivation for one of ordinary skill in the art to modify a reference or combined references.<sup>5</sup> The cited publications should explicitly provide a reasonable expectation of success, determined from the position of one of ordinary skill in the art at the time the invention was made.<sup>6</sup>

Applicants assert that Lybarger et al. does not disclose, teach or suggest anything about mirror stop arrangement or the micromirror array is automatically adjusted on the basis of the separation points in such a way that the wavelength regions determined by the separation points are each allocated to one channel, as claimed in dependent claim 16. Therefore, Claim 16 is patentable over Lybarger et al. Allowance of Claim 16 is respectfully requested.

Applicants believe that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. Should any questions arise, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

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<sup>5</sup> *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

<sup>6</sup> *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970);

*Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996);